

ESTTA Tracking number: **ESTTA648042**

Filing date: **01/02/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056509
Party	Plaintiff Autodesk, Inc.
Correspondence Address	JOHN L SLAFSKY WILSON SONSINI GOODRICH ROSATI 650 PAGE MILL RD PALO ALTO, CA 94304 1050 UNITED STATES jslafsky@wsgr.com, trademarks@wsgr.com
Submission	Opposition/Response to Motion
Filer's Name	JOHN L SLAFSKY
Filer's e-mail	jslafsky@wsgr.com, trademarks@wsgr.com
Signature	/JOHN L SLAFSKY/
Date	01/02/2015
Attachments	Petitioner Opposition to Respondent Motion to Compel Depositions on Oral Examination.pdf(3235224 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Petitioner,

v.

3D SYSTEMS, INC.,

Respondent.

Cancellation No. 92056509

**PETITIONER’S OPPOSITION TO RESPONDENT’S
MOTION TO COMPEL DEPOSITIONS ON ORAL EXAMINATION**

Autodesk, Inc. (“Petitioner” or “Autodesk”), by and through its undersigned counsel, hereby responds to and opposes the December 13, 2014 Motion to Compel Depositions on Oral Examination filed by Respondent 3D Systems, Inc. (“Respondent”). Petitioner submits together with this Opposition the supporting declarations of Luke Liss (“Liss Decl.”), Chris Young (“Young Decl.”) and Maurice Patel (“Patel Decl.”).

INTRODUCTION

This cancellation proceeding has been pending for over two years. Accordingly, in its order dated October 30, 2014 (the “Discovery Order”) (Docket No. 29), the Board closed discovery for Respondent and only permitted Petitioner a limited time period for completing certain “follow-up” discovery. Now, shortly before the parties’ trial testimony periods are scheduled to begin, Respondent calls for the Board to re-open the discovery period and to permit Respondent to take depositions on oral examination of certain Canadian employees of Petitioner. There is no basis, however, for this eleventh-hour request.¹

First, the time has passed for Respondent to raise this issue. Respondent noticed depositions of Petitioner on August 6, 2014. Petitioner promptly responded, via a detailed letter

¹ Petitioner was not able to conduct the follow-up discovery called for by the Board, as Respondent challenged the Discovery Order via its pending Motion for Reconsideration (Docket No. 30), effectively blocking Petitioner from key documents and information.

as well as lengthy formal objections to the deposition notices, that the witnesses are Canadian residents and that the Board's general procedures call for depositions of foreign witnesses on written questions. Respondent unilaterally adjourned the depositions and promised that it would quickly "take action" on the deposition issues. However, Respondent failed to take any action whatsoever: it did not raise the issue of depositions again for nearly four months, until the eve of trial and well after the Board had closed the discovery period.

Second, even were the Board inclined to re-open the discovery period for Respondent and allow it at this late stage to proceed with discovery depositions, there is no need to deviate from the Board's standard practices concerning depositions of foreign witnesses. As set forth in the accompanying declarations, and as Respondent has been well aware since at least as early as August 2014, the business team supervising Petitioner's 3DS MAX® brand (the mark to which Petitioner cites in its Petition) is not in the U.S. but is in Canada. To the extent Respondent is going to proceed with depositions of Petitioner's employees, Messrs. Young and Patel, these depositions should thus follow the ordinary procedure of depositions via written questions under TBMP § 404.03(b); likewise, to the extent Respondent is going to proceed with a Rule 30(b)(6) deposition of Petitioner directed at Petitioner's 3DS MAX® business, that deposition should, too, follow the same general TBMP requirements. Respondent has not shown good cause otherwise.

Petitioner's objections to these depositions were timely, particularized and well-founded, pursuant to both the TBMP and case law. Respondent disagreed with Petitioner's position, vowing in August to "take action" before the Board. Respondent did no such thing, however, and given its prolonged failure to act, it cannot now be heard, on the eve of trial, to complain about the Board's standard rules and procedures.²

² Insofar as Respondent has specific questions about the select documents produced to Respondent on January 2, 2014, and insofar as the Board does decide to re-open Respondent's discovery period, Respondent may direct its questions concerning those documents via interrogatories or depositions on written questions, and Petitioner will not object based on timeliness.

I. BACKGROUND

A. Petitioner and 3DS MAX ®

Petitioner develops and distributes computer-aided design software for, among other things, modeling, animation and 3D printing. *See* www.autodesk.com. Petitioner has asserted a likelihood of confusion claim against Respondent's registered 3DS (and design) trademark, Registration No. 4,125,612. Petitioner bases this claim, in large part, on a prior registration of its 3DS MAX trademark, Registration No. 2,733,869. Docket 1. "3DS MAX is Petitioner's name for its industry-leading computer graphics software for making animations, models and images. This software is used by architects, video and television producers, game developers and movie special-effects experts, among others." *See id.* at 1, ¶ 3.

B. Petitioner's Canada Business

Petitioner is headquartered in California, but as set forth in its Petition does business in approximately 160 countries. *See* Docket 1, ¶ 1. Petitioner's offices include its office in Montreal, Quebec, Canada, which is where the business leadership team for its 3DS MAX-related products in its Media and Entertainment Division has long been based. *See* Patel Declaration and Young Declaration, respectively; *see also* Liss Decl. Ex. 1 at p. 3 (August 22, 2002 *Toronto Globe & Mail* article noting 3DS MAX tool was from Montreal-based division of Autodesk).

As Messrs. Patel and Young have declared under oath, they both reside and work in Montreal. Young Decl. ¶ 1; Patel Decl. ¶ 1.

C. Respondent's August 2014 Deposition Notices and Petitioner's Prompt Response

On August 6, 2014, Respondent served four deposition notices, including notices for Messrs. Patel and Young, as well as a Rule 30(b)(6) witness.³ *See* "Resp's Depo. Motion" at 2

³ The other notice was for Autodesk employee Lisa Turbis, and is not at issue in this motion as she is based in California. However, Respondent also has made no efforts to pursue her deposition, and as set forth above, the Board has closed the discovery period for Respondent.

and Ex. C (Respondent's deposition notices). Significantly, on August 11, 2014, Respondent unilaterally adjourned such depositions "*sine dia*."⁴

Petitioner first responded to Respondent's deposition notices on August 12, 2014 via letter. In particular, Petitioner alerted Respondent that certain of its deposition notices were invalid for the following reasons:

First, Chris Young and Maurice Patel are persons residing and working in Canada. The TBMP requires that depositions of such persons be taken on written questions. TBMP § 404.03(b); 37 CFR § 2.120(c). Accordingly, the deposition notices for Messrs. Young and Patel served on August 6, 2014 are facially invalid, and must be properly noticed in compliance with 37 CFR § 2.124 and TBMP §§ 404.07(d)-(e) ...

Second, your notice of deposition pursuant to Rule 30(b)(6) includes 19 different topics, nearly all of which pertain to the 3DS MAX mark, which is part of our Media & Entertainment business division, based in Canada. Accordingly, the most appropriate and knowledgeable witnesses for the 30(b)(6) testimony are very likely located outside the U.S. As explained above, such deposition(s) must be taken on written questions and noticed accordingly. TBMP § 404.03(b); 37 CFR § 2.120(c). Once any such deposition(s) have been scheduled, Autodesk intends to respond by designating such persons; however, at that time you will need to re-notice with respect to any designated witnesses located outside the U.S., in accordance with the applicable rules, following the Board's resolution of the pending motion to compel.

See Resp's Depo. Motion Ex. E (Petitioner's August 12, 2014 letter). Petitioner also served detailed formal objections to Respondent's deposition notices that specifically called out the above points, among others, on August 22, 2014. *See id.*, Ex. H (Petitioner's deposition objections).

Respondent followed up on August 25 via letter, claiming, among other things, that it believed its depositions were "duly noticed, and not deficient." *Id.* Ex. F. Respondent further stated that "[p]lease let us know within five (5) business days if you will stipulate to make Mr. Patel and Mr. Young available for deposition on oral examination in either the U.S. or Canada. If we do not hear from you in this time, *we will assume that you disagree with our position and*

⁴ Such adjournment came after Petitioner filed its initial motion to compel on August 7, 2014. Pursuant to TBMP § 523.01 (*see also* Docket 26), given that Respondent had noticed its depositions on August 6, it could have sought to proceed with the depositions instead of adjourning them. Respondent chose not to proceed.

will take action accordingly.” Id. (emphasis added). Petitioner responded within three days, reiterating its position. Resp’s Depo. Motion Ex. G (August 28, 2014 letter by Petitioner).

D. Respondent’s Inaction

Despite its promise to “take action,” Respondent remained silent and took no action on the issue of discovery depositions for almost four months. During this period, Respondent opposed Petitioner’s Motion to Compel Discovery (Docket 27), but did not raise the issue of its own depositions and/or otherwise alert the Board it would need additional time for discovery. Accordingly, when the Board issued its Discovery Order, it stated that it was extending discovery “only to allow Petitioner time in which to review Respondent’s discovery responses compelled by this order and to conduct follow-up, if necessary.” Docket 29 at p. 7 n.4.

Following the Discovery Order, Respondent continued to remain silent on the issue of depositions for well over a month – even as it filed a Motion for Reconsideration challenging the Discovery Order. Indeed, while it broadly attacked the Board’s Order, Respondent’s Motion for Reconsideration *did not seek to re-start and extend discovery for Respondent.* See Docket 30.

On December 10, 2014, over three months after it promised to take prompt action, and well after the Board had closed the period for Respondent to take discovery, Respondent insisted during a telephonic meet-and-confer between counsel that Respondent should be entitled to take discovery depositions of foreign witness on oral examination. The instant motion followed on December 13, 2014.

ARGUMENT

II. RESPONDENT’S DISCOVERY PERIOD SHOULD REMAIN CLOSED

As set forth above, Respondent did nothing to pursue deposition testimony from August through the early portion of December. Respondent could (and should) have timely done any or all of the following: (1) refrained from unilaterally adjourning its depositions of Petitioner; (2) alerted the Board that it needed additional time for its own discovery in opposition to Petitioner’s Motion to Compel (*see* Docket Nos. 25, 27); and/or (3) immediately sought relief following the

Discovery Order, which made clear that Respondent's time for discovery was over.⁵

Respondent, however, took none of these steps, all of which were easily within its "reasonable control." *See, e.g., FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1922 (Fed. Cir. 2007) (affirming refusal to re-open testimony period where "the reasons given for delay were wholly within [movant's] reasonable control."); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1892 (TTAB 2010) (denying motion to re-open discovery, noting that the "failure to seek an extension of the discovery period before it closed, [was] entirely within [movant's] reasonable control.").

Respondent makes no mention of its prolonged inaction and fails to make any showing of "excusable neglect."⁶ *See* Fed. R. Civ. P. 6(b) and TBMP § 509(1)(B) (both requiring that a party show "excusable neglect" when seeking an extension of time post-expiration); *see also Luster Prods. Inc. v. Van Sandt.*, 104 USPQ2d 1877, 1880 (TTAB 2012) (denying motion to re-open discovery where "applicant's failure to timely act before the close of the discovery period did not result from excusable neglect."); *Pumpkin Ltd.*, 43 USPQ2d at 1588 (denying motion to re-open testimony period where movant's failure to adhere to schedule was "caused solely by [movant's] negligence and inattention[.]").

⁵ Petitioner anticipates that Respondent will likely try to use the Board's suspension of proceedings (from August 8 to October 30, 2014) as a justification for its inaction. *See* Docket 26, 29. However, Petitioner respectfully submits that such suspension would not have foreclosed Respondent from timely pursuing any of the foregoing courses of action (*i.e.*, Respondent did not have to unilaterally adjourn its depositions of Petitioner), and further points out that Respondent continued to take no action to pursue depositions for well over a month after the suspension was lifted.

⁶ While Respondent's motion requests that the Board "reset the discovery period to allow sufficient time Respondent to complete discovery" (sic), Respondent does not address the factors that determine whether its delay in seeking such relief after the close of its discovery is excusable. They are: (1) the danger of prejudice to the non-moving party; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. *See Pioneer Inv. Servs. Co. v. Brunswick Assocs. LP*, 507 U.S. 380, 395 (1993). The factors *do not* carry equal weight (*see FirstHealth of the Carolinas Inc.*, 81 USPQ2d at 1921-22), and the Board has noted that multiple courts have stated the third factor – the reason for the delay – may be considered the most important. *See, e.g., Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn.7 (TTAB 1997).

Instead, Respondent complains that: (1) Petitioner's initial disclosures listed Autodesk's counsel as contact for identified individuals; and (2) that "in response to Interrogatories explicitly asking for the address of individuals ... Petitioner identified Mssrs. Young and Patel, but was silent as to their location, thereby obscuring their location outside the United States." Resp's Depo. Motion at 6-7. The notion that Petitioner somehow "obscured" the location of its witnesses is baseless. First, Petitioner disclosed their location, in writing, repeatedly, in August 2014. Second, *Respondent ignores that it answered discovery propounded by Petitioner concerning the location of Respondent's witnesses in the exact same manner.* Third, the location of these witnesses is readily available online.⁷

In particular, in Respondent's own Initial Disclosures Respondent's counsel identified itself as the sole contact for its witnesses. *See* Liss Decl. Ex. 2. at ¶ 1. Similarly, Respondent refused to provide the "known address and telephone number" of identified individuals (Liss Decl. Ex. 3. at ¶ 10(a), in its interrogatory responses (Liss Decl. Ex. 4).⁸

In sum, Respondent's tangential (and misplaced) focus on Petitioner does not substitute for the required showing of excusable neglect.

III. THE DEPOSITIONS OF AUTODESK'S FOREIGN WITNESSES ARE PROPERLY TAKEN ON WRITTEN QUESTIONS

There is nothing improper, unusual or prejudicial in the taking of depositions of foreign witnesses via written questions in TTAB proceedings. Indeed, this procedure is explicitly contemplated under the TBMP. *See, e.g.*, TBMP § 520 ("Ordinarily, the discovery deposition of a natural person who resides in a foreign country ... must, if taken in a foreign country, be taken upon written questions in the manner described in 37 CFR § 2.124."); *see also* TBMP § 404.03(b) (setting forth that deposition of foreign resident that is a party, officer of a party, or

⁷ It bears note that among the first results of a simple Google search of either of Mr. Young or Mr. Patel's names along with "Autodesk" brings up their respective LinkedIn profiles that make clear both are based in Canada.

⁸ Indeed it was not until December 10, 2014, that Respondent's counsel informed Petitioner's counsel – for the first time – that one of its witnesses it had identified in its Initial Disclosures did not, in fact, reside in South Carolina, where Respondent is headquartered.

designated 30(b)(6) witness “*must* be taken on written questions ... unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.”) (emphasis added).⁹ In order to deviate from such standard, a party seeking an oral deposition must either secure consent or establish “good cause” as to why it needs oral testimony. Here, Petitioner has not consented to depositions of these witnesses on oral examination, and Respondent has failed to show good cause for a deviation from the Board’s usual procedures.

Respondent bases its “good cause” argument on a false premise – that “Petitioner now claims that all of its material witnesses are located outside the United States, thereby depriving Respondent of the unquestionable advantage of being able to confront a witness by way of oral cross-examination.” Resp’s Depo. Motion at 5. Petitioner has never made such a claim. In any event, to the extent that Petitioner does ultimately call foreign witnesses during its trial testimony periods, it represents that it will make such witnesses available for oral cross-examination by Respondent at that time. Thus, Respondent will not be deprived of the opportunity to test Petitioner’s material witnesses during the trial period and it will suffer no prejudice by proceeding pursuant to the Board’s standard discovery procedures.

The cases cited by Respondent (the most recent of which is 25 years old) only highlight the lack of support for its position that any “good cause” exists here. In particular, Respondent attempts to rely on *Orion* for the proposition that it would be “unjust” to deprive Respondent of oral discovery depositions. *See Orion Grp. Inc. v. The Orion Ins. Co. PLC*, 12 USPQ2d 1923 (TTAB 1989). Yet in *Orion*, the Board found only “good cause” to order an oral deposition where a motion for summary judgment was pending based *solely* on the affidavit of the expert witness opposer sought to depose:

⁹ As set forth in Section I.C., above, because the Rule 30(b)(6) topics selected by Respondent bear heavily on Petitioner’s 3DS MAX® mark, which is part of Petitioner’s Media & Entertainment business division based in Montreal, the most appropriate 30(b)(6) witnesses for Respondent’s 3DS MAX® – related deposition topics would most naturally be Montreal employees.

Applicant now seeks summary judgment as a matter of law based on the affidavit of one person ... Applicant, in effect, is requesting judgment in its favor without a trial and without allowing opposer an opportunity to obtain discovery on the issues involved in this case.

Id. at 1925-1926. Here, there is no dispositive motion pending. *Orion* is easily distinguishable.

Likewise, Respondent's reliance on *Century 21* misses the mark. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 15 U.S.P.Q.2d 1079 (TTAB 1990). In particular, that case involved an expert witness *who was located in California, not in a foreign country.* *Id.* at 1080. For that reason alone it is inapplicable to this case, which involves witnesses that work and reside in Canada. *See* Young Decl. ¶ 1; Patel Decl. ¶ 1. Moreover, the motion in *Century 21* was in the context of the trial testimony period rather than the discovery period. *Id.*; *cf. Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (rejecting citation of cases involving discovery depositions in context of trial testimony as "inapposite").¹⁰

Decisions far more recent than any of the cases relied upon by Respondent are consistent with the Board's general preference for depositions of foreign witnesses upon written questions. *See, e.g., Nashin v. Prod. Source Int'l LLC*, 107 U.S.P.Q.2d 1257, 1259 n. 3 (TTAB 2013) (discussing procedure of written depositions, noting that "Petitioner's witnesses were located in Israel and Canada, which we assume is the reason that their depositions were taken on written questions."); *Jain*, 49 USPQ2d at 1431 ("Under the Board's practice, discovery depositions of foreign-resident witnesses may be taken only by way of written questions, unless the parties stipulate otherwise or unless the Board, upon motion for good cause shown, orders that the deposition be taken orally in the foreign country.").

Indeed, in 2010 the Board in *Oxford Tutoring* quashed a notice of deposition of a foreign (Canadian) witness, noting the following:

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a person designated under Fed. R. Civ. P. 30(b)(6) ... to

¹⁰ The only other case cited in passing in Respondent's motion is a Supreme Court case which had nothing to do with TTAB proceeding – rather it was a personal injury action involving the crash of a plane manufactured in France. *See Société Nationale Industrielle Aérospatiale v. United States Dist. Ct. for the Southern Dist. of Iowa*, 482 U.S. 522, 539–40, 107 S.Ct. 2542, 96 L.Ed.2d 461 (1987)

testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in Trademark Rule 2.124. Moreover, the board will not order a natural person, including a person designated under Fed. R. Civ. P. 30(b)(6), residing in a foreign country to come to the United States for the taking of his or her discovery deposition.

Liss Decl. Ex. 5 at 3-4 (citing cases and the TBMP). The decision in *Oxford Tutoring* underscores the general rule that deposition of foreign witnesses are properly taken on written questions, and also makes clear that such rule applies even in the case of a designated 30(b)(6) witness.

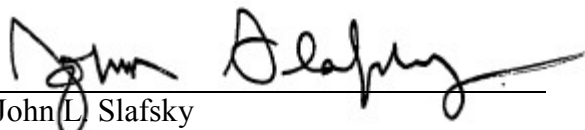
In sum, if the Board believes that Respondent should be allowed to pursue discovery depositions even after its prolonged inaction, Respondent has not provided any cause – let alone the required “good cause” – sufficient to deviate from the ordinary course of written depositions of foreign witnesses.

CONCLUSION

For the reasons stated above, the Board should deny Respondent’s request to re-open its discovery period and deny Respondent’s Motion to Compel Depositions on Oral Examination in its entirety. Alternatively, should the Board be inclined to allow Respondent to take discovery depositions, then depositions of Petitioner’s foreign witnesses should be taken on written questions pursuant to the ordinary TBMP procedure.

Dated: January 2, 2015

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
John L. Slafsky
Luke A. Liss
Stephanie S. Brannen
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, California 94304-1050
Tel: (650) 493-9300
Fax: (650) 493-6811
trademarks@wsgr.com

Attorneys for Petitioner
AUTODESK, INC.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Petitioner,

v.

3D SYSTEMS, INC.,

Respondent.

Cancellation No: 92056509

DECLARATION OF CHRIS YOUNG

I, Chris Young, declare:

1. I reside in Montreal, Quebec, CANADA.

2. I am Vice President, Video Solutions Group, Media and Entertainment, for Petitioner Autodesk, Inc. ("Autodesk"). The Media and Entertainment Division at Autodesk is responsible for the company's 3DS MAX-related products.

3. The business leadership team for Autodesk's 3DS MAX-related products is based in Montreal, Quebec, CANADA.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed at Montreal, Quebec, CANADA on December 17, 2014.


CHRIS YOUNG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Petitioner,

v.

3D SYSTEMS, INC.,

Respondent.

Cancellation No: 92056509

DECLARATION OF MAURICE PATEL

I, Maurice Patel, declare:

1. I reside in Montreal, Quebec, CANADA.
2. I am Senior Industry Manager for the Media and Entertainment Division of Petitioner Autodesk, Inc. ("Autodesk"). This is the Autodesk Division responsible for Autodesk's 3DS MAX-related products.
3. The business leadership team for Autodesk's 3ds MAX-related products is based in Montreal, Quebec, CANADA.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed at Montreal, Quebec, CANADA on December 17, 2014.



MAURICE PATEL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Petitioner,

v.

3D SYSTEMS, INC.,

Respondent.

Cancellation No. 92056509

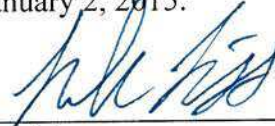
**DECLARATION OF LUKE LISS
IN SUPPORT OF PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO
COMPEL DEPOSITIONS ON ORAL EXAMINATION**

I, Luke Liss, declare:

1. I am an associate at Wilson Sonsini Goodrich & Rosati, counsel for Petitioner Autodesk, Inc. ("Autodesk") in this matter. I have personal knowledge of the facts set forth in this declaration, and if called as a witness I could competently testify to them.
2. Attached hereto as Exhibit 1 is a true and correct copy of Toronto Globe & Mail article downloaded from Westlaw dated August 22, 2002.
3. Attached hereto as Exhibit 2 is a true and correct copy of Initial Disclosures of Respondent, 3D Systems, Inc., dated November 11, 2013.
4. Attached hereto as Exhibit 3 is a true and correct copy of Petitioner's First Set of Interrogatories to Registrant, dated September 6, 2013.
5. Attached hereto as Exhibit 4 is a true and correct copy of Respondent's Responses and Objections to Petitioner's First Set of Interrogatories to Registrant, dated January 17, 2014.

6. Attached hereto as Exhibit 5 is a true and correct copy of a TBMP decision in *Oxford Tutoring Inc. v Oxford Learning Centres Inc.*, dated March 22, 2010.

I declare that the foregoing is true and correct to the best of my knowledge and recollection. Executed at Palo Alto, California, on January 2, 2015.



Luke Liss

EXHIBIT 1

8/22/02 Globe & Mail (Toronto Can.) B12
2002 WLNR 12064276

Globe and Mail
Copyright 2002 by The Globe and Mail

August 22, 2002

Section: Report on Business 1000 Magazinee

3D interface draws praise from digital animators
DSI's HandGear system allows designers

By Grant Buckler

A diagram of a three-dimensional object seems to float in space on a computer screen. A digital animator wants to alter the object's shape, rotate and move it in three dimensions, even program a flight path to move the object through space.

Currently, the standard way to do this is to select various parameters — the x, y and z axes — from menus and make various awkward movements with a mouse.

But what if you could just hold a hand out and twist as though actually manipulating the object with your fingers?

That's the idea behind a novel computer interface aimed at speeding up the often painstaking process of 3D digital animation and design. The interface, called HandGear, is made by Montreal-based DSI Datotech Systems Inc. It looks like one of those old Etch-a-Sketch drawing pads but works more like an oversized laptop-style track-pad, sensitive to the movements of not just one, but two or more fingers at a time.

The number of fingers touching the pad can determine how movements are interpreted. Place the thumb and index finger on the pad and twist and the object rotates in two dimensions. Twist three fingers, and the object spins around in three dimensions.

Meanwhile, the user's other hand works the mouse or keyboard to do things such as selecting which object to work with or choosing colours and textures. "Think of a sculptor holding an object in his left hand and doing painting or deformations with his right hand," says Tim Heaney, DSI's vice-president of marketing.

A series of programmable buttons provides further control — for instance, locking the size of an object or its position in any dimension.

Sylvain Taillon, executive producer and co-owner of Topix Computer Graphics and Animation Inc. in Toronto, a maker of animated television commercials that is a customer of DSI's, says the HandGear looks as if it will make the animation process more intuitive. "To be able to go in and actually manipulate something with your hand," Mr. Taillon says, "that's a very interesting process."

DSI started in Vancouver in 1996, but the HandGear, which costs \$585 (U.S.), was released this year and got its official coming-out party at the Siggraph computer graphics trade show in Texas last month.

Some early test users are enthusiastic. "We already see some major improvement in our work flow," says Luc Larouche, president of Side City Studios Inc., a Montreal-based video game development company with international clients stretching from Hollywood to England. "We were looking for a way to accelerate the process without sacrificing quality."

Mr. Larouche, whose company has been testing two prototype HandGear units, has placed an order for seven commercial models and believes the technology will eventually come standard with graphics animation workstations. "That's what we all think, that it will be dominant in the industry," he added.

DSI grew from attempts to use gesture-recognition technology in therapy for dyslexics. Using three fingers on a touch-sensitive pad, users were supposed to express phonemes — basic units of speech — to drive a speech synthesizer. An American researcher named Seth McCloud had worked on the idea since the 1980s but found it hard to put into practice.

He handed his work over to DSI, which decided it could not make the dyslexia therapy idea work, but it could apply the research in other ways. The first was animation.

DSI developed software that could work with existing animation tools, but could not find suitable input hardware, explains Robert Egery, DSI's president and chief operating officer. So DSI designed its own touch pad. The company contracts out the manufacture of the pad and concentrates on software development.

DSI is listed on the TSX Venture Exchange but has raised most of its capital through a series of private placements, Mr. Egery says. He expects sales of \$1-million (U.S.) this year, rising to \$10-million next year and \$35-million in 2004.

Last year, DSI began relocating from Vancouver to Montreal. The Montreal office has grown to 14, and eventually DSI will be entirely in Montreal, he says.

Mr. Egery, who joined the company in December, 2000, trimmed its staff from a high of about 30 — the work force was too heavy on the research side, he says — but expects it to rebound to nearly that level by next year.

Proximity to major animation software vendors is essential to the company's success, Mr. Egery says. DSI's first-generation software is compatible with the **3ds** max animation tool from Discreet Logic, the **Montreal**-based division of Sausalito, Calif.-based **Autodesk** Inc. Versions that will work with products from the **Montreal**-based SoftImage unit of Avid Technology Inc. in Tewksbury, Mass., and Toronto-based Alias Wavefront, a division of Silicon Graphics Ltd. in Mountain View, Calif., are in the works.

Once DSI is established in the animation market, Mr. Egery wants to branch out to computer-aided design and manufacturing (CAD/CAM), then to computer game development.

The possibilities don't end there. Another interesting field is biometrics, Mr. Egery says. Imagine a device that could verify your identity by the way you sign your name on a touch-sensitive pad. That's for the future, though: DSI wants to focus on one market at a time. "The worst thing you can do is chase everything that moves," Mr. Egery says.

---- INDEX REFERENCES ---

COMPANY: DYWIDAG SYS INTL GMBH; SILICON GRAPHICS LTD; [AVID TECHNOLOGY INC](#)

INDUSTRY: (I.T. (1IT96); Automated ID (1AU05); Scientific, CAD, CAM & CAE Software (1SC75); Multimedia Production, Graphics & Publishing Software (1MU67); Software (1SO30); Computer-Aided Engineering (1CO76); Application Software (1AP32); Multimedia Software Applications Development (1MU49); Industrial & Manufacturing Software (1IN43); Application Software Development (1AP78); I.T. Vertical Markets (1IT38); I.T. in Security (1IT64); Software Products (1SO56); I.T. in Engineering & Architectural Services (1IT65); Computer-Aided Design (1CO50); 3D Animation & Rendering (13D60))

REGION: (Americas (1AM92); North America (1NO39); USA (1US73); Canada (1CA33); California (1CA98))

Language: EN

OTHER INDEXING: (ANIMATION INC; AVID TECHNOLOGY INC; CAM; DSI; DSI DATOTECH SYSTEMS INC; ETCH A SKETCH; SIDE CITY STUDIOS INC; SILICON GRAPHICS LTD; TOPIX COMPUTER GRAPHICS; TSX VENTURE EXCHANGE) (Alias Wavefront; Autodesk Inc.; Egery; Imagine; Larouche; Luc Larouche; Proximity; Robert Egery; Seth McCloud; Sylvain Taillon; Taillon; Tim Heaney)

KEYWORDS: (computers); (software); (animation); (technology)

COMPANY TERMS: DSI DATOTECH SYSTEMS INC

EDITION: Metro

Word Count: 1064

8/22/02 GLOBEMAIL B12

END OF DOCUMENT

EXHIBIT 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Autodesk, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent.)	
)	

INITIAL DISCLOSURES OF RESPONDENT, 3D SYSTEMS, INC.

Respondent, 3D Systems, Inc. ("3D Systems"), hereby makes its initial disclosures in this matter, pursuant to 37 C.F.R. § 2.120 and Rule 26(a)(1), Federal Rules of Civil Procedure, as follows:

1. "the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information - that the disclosing party may use to support its claims and defenses, unless the use would be solely for impeachment;"
 - a. Avi Reichenthal, President/CEO, 3D Systems
 - i. Mr. Reichenthal may be contacted through counsel for 3D Systems, Sneed PLLC, 610 Jetton St., Suite 120-107, Davidson, NC 28036, (704) 779-3611.
 - ii. Mr. Reichenthal is likely to have discoverable information concerning the creation and use of the 3DS & Design Mark, and communications with Petitioner concerning the 3DS & Design Mark, Petitioner's 3DS MAX Mark and this Cancellation Proceeding, generally.
 - b. Cathy Lewis, Chief Marketing Officer, 3D Systems
 - i. Ms. Lewis may be contacted through counsel for 3D Systems, Sneed PLLC, 610 Jetton St., Suite 120-107, Davidson, NC 28036, (704) 779-3611.
 - ii. Ms. Lewis is likely to have discoverable information concerning the creation and use of the 3DS & Design Mark, including, without limitation, development and creation of the 3DS & Design Mark;

advertising, marketing and promotional activities in connection with the 3DS & Design Mark; advertising and promotional expenditures pertaining to the 3DS & Design Mark; and 3D Systems' market strength.

- c. James Hopeck, Vice-President and Corporate Controller
 - i. Mr. Hopeck may be contacted through counsel for 3D Systems, Sneed PLLC, 610 Jetton St., Suite 120-107, Davidson, NC 28036, (704) 779-3611.
 - ii. Mr. Hopeck is likely to have discoverable information concerning the use of the 3DS & Design Mark, including, without limitation, the scope of 3D Systems' products and services offered and sold in connection with the 3DS & Design Mark; the channels of trade in which the 3DS & Design Mark is used; 3D Systems' relationships with its customers; 3D Systems' relationships with potential purchasers; sales volume and revenues in connection with the 3DS & Design Mark; and the strength and notoriety of the mark.
 - d. Carl Bass, President and Chief Executive Officer, Autodesk, Inc.
 - i. Upon information and belief, Mr. Bass may be contacted through counsel for Petitioner, Autodesk, Inc.
 - ii. Mr. Bass is likely to have information regarding the products and services offered and sold under the 3DS MAX Mark, likelihood of confusion (or lack thereof) between the 3DS & Design Mark and the 3DS MAX Mark, actual confusion (or lack thereof) between the 3DS & Design Mark and the 3DS MAX Mark, and disputed rights of the parties in this Cancellation Proceeding, generally.
 - e. Customers of 3D Systems regarding, *inter alia*, the strength and notoriety of the 3DS & Design Mark; longstanding use of the 3DS & Design Mark by 3D Systems; the range of goods and services offered and sold by 3D Systems; and the trade channels and purchasers of 3D Systems' goods and services in connection with the 3DS & Design Mark.
 - f. Witnesses suitable for impeachment purposes;
 - g. Witnesses identified during discovery in this proceeding;
 - h. Witnesses identified by Autodesk, Inc. ("Petitioner"); and
 - i. Petitioner's company representative(s), regarding, *inter alia*, Petitioner's activities, trademark registrations and claims in this proceeding.
2. "a copy - or a description by category and location - of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment;"
- a. File history of 3DS & Design mark (U.S. Reg. No. 3,475,368);

- b. File history of Petitioner's 3DS MAX mark (U.S. Reg. No. 2,733,869);
- c. Documents and things regarding 3D Systems' use of its 3DS & Design Mark, including documents regarding advertising and promotions of the goods and services associated with the 3DS & Design Mark in the United States;
- d. Documents and things sufficient to impeach Petitioner and any of Petitioner's witnesses;
- e. Documents and things discovered during discovery in this proceeding from Petitioner or any other source; and
- f. Documents and things identified, produced or introduced by Petitioner.

Documents referenced in section 2(a)-(b) of this section are publicly available through the PTO, documents referenced in section 2(c) are in the possession of 3D Systems and/or its counsel, and documents referenced in sections 2(d)-(f) are in the possession of Petitioner, 3D Systems, or have not yet been discovered in this matter.

Dated: November 11, 2013

Respectfully Submitted,



Sarah C. Hsia
Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036
Tel: 704-779-3611
sarah@sneedlegal.com
JSneed@SneedLegal.com

*Attorneys for Respondent
3D Systems, Inc.*

Certificate of Service

The undersigned counsel of record hereby certifies that on this 11th day of November, 2013, a true and correct copy of the foregoing *Initial Disclosures of Respondent 3D Systems, Inc.* was served on counsel for the Petitioner, Autodesk, Inc., by placing a copy in U.S. Mail, postage prepaid, and addressed to the following:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050
Attorneys for Petitioner



An Attorney for Respondent

EXHIBIT 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,

Petitioner,

v.

3D SYSTEMS, INC.,

Registrant.

**PETITIONER'S FIRST SET OF
INTERROGATORIES TO
REGISTRANT**

Cancellation No. 92056509

Registration No. 4,125,612
Mark: 3DS AND DESIGN

Pursuant to Trademark Rule of Practice 2.120 (37 C.F.R. § 2.120), Trademark Trial and Appeal Board Manual of Procedure § 405, and Federal Rule of Civil Procedure 33, Petitioner Autodesk, Inc. requests that Registrant 3D Systems, Inc. answer the following Interrogatories separately and fully, in writing, under oath within thirty (30) days after date of service.

For the purpose of these Interrogatories, the following definitions and instructions shall apply:

DEFINITIONS

1. The terms "3D Systems," "Registrant," "you," "your" and "yourself" refer to Registrant 3D Systems, Inc., and include any persons controlled by or acting on behalf of that entity, including but not limited to all officers, directors, owners, employees, or agents, and any predecessors, subsidiaries, parent companies, affiliated companies or joint venturers.

2. The terms "Autodesk" or "Petitioner" refer to Petitioner Autodesk, Inc., and include any persons controlled by or acting on behalf of that entity, including but not limited to

all officers, directors, employees, or agents, and any predecessors, subsidiaries, parent companies, affiliated companies, or joint venturers.

3. The term “3DS,” “the mark 3DS,” or “the 3DS mark” means any word, name, symbol or device or other designation of origin incorporating the letter string 3DS, or its phonetic equivalent as well as any domain name incorporating the letter string 3DS. This definition includes but is not limited to the trademark in United States Patent and Trademark Office (“USPTO”) Registration No. 4,125,612 for the mark 3DS AND DESIGN.

4. The term “3DS Product or Service” means any product or service offered for sale, offered for distribution, sold, distributed, advertised, marketed, or promoted in the U.S. – by you or by your licensees—in connection with the mark 3DS.

5. The term “Answer” means 3D Systems’ ANSWER that was filed in the above-captioned proceeding with the Trademark Trial and Appeal Board (“TTAB”) on April 23, 2013.

6. The term “Petition for Cancellation” means the Petition for Cancellation filed by Petitioner in the above-captioned proceeding with TTAB on November 29, 2012.

7. The term “person” means any natural person or any business, legal or governmental entity, or association.

8. Unless otherwise stated, the scope of these Interrogatories is the United States.

9. The term “document” as used herein is synonymous in meaning and equal in scope to the usage of this term in Federal Rule of Civil Procedure 34, any “writings and recordings” and “photographs” as defined by Federal Rule of Evidence 1001, and its interpretation by the courts, and includes, without limitation, all originals, drafts, and non-identical copies of any written, printed, typed, recorded, electronic, magnetic, optical, punched, copied, graphic or other tangible thing in, upon or from which information may be conveyed,

embodied, translated, or stored (including, but not limited to, papers, records, books, correspondence, contracts, minutes of meetings, memoranda, notes on desk calendars and appointment books, intra-office communications, canceled checks, invoices, telegrams, telexes, dictation or other audio tapes, video tapes, studies, electronic mail, information stored in computer readable form, on a compact disc, or any other type of data storage device or medium, computer printouts, microfilm, microfiche, laser disks, diaries, calendars, photographs, charts, viewgraphs, drawings, sketches and all other writings or drafts thereof), as well as all other tangible things subject to production under Federal Rule of Civil Procedure 34.

10. The term “identify,” when referring to:

- a. a natural person, means to give his or her full name, present or last known address and telephone number, last known place of employment and job title;
- b. a public or private corporation, partnership, association, agency or other entity, means to give its present or last known address and telephone number, and state of incorporation, if applicable;
- c. a document, means to state its general character, title, date, addressee or recipient, author or signatory, present location, and who has possession, custody or control of the document;
- d. a product, means to provide a description of the item which is offered for sale, and the intended customer groups, channels of trade, approximate price, and market for the product;
- e. a service, means to describe the service and the intended customer groups, channels of trade, approximate price, and market for the service.

11. The term “communication” is defined as any transmission or exchange of information between two (2) or more persons, orally or in writing, and includes, without limitation, any conversation or discussion, whether face-to-face or by means of telephone, letter, facsimile, electronic, digital or other media.

12. The terms “relating to” and “related to” mean concerning, containing, evidencing, describing, constituting, referring to, explaining, discussing or reflecting.

13. The terms “and” and “or” and the term “and/or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the request all responses that might otherwise be construed to be outside its scope.

14. The use of a present tense shall include past tenses and vice versa.

15. The use of the singular form of any word also includes the plural and vice versa.

16. The terms “all” and “each” shall each be construed to include the other.

INSTRUCTIONS

1. In answering these Interrogatories, furnish all information, including information contained in or on any document that is known or available to you, including all information in the possession of your attorneys or other persons acting on your behalf or under your attorneys’ employment or direction.

2. If you cannot answer any interrogatory fully and completely after exercising due diligence to make inquiries and secure information necessary to do so, so state, and answer each such interrogatory to the full extent you deem possible; specify the portion of such interrogatory that you claim you are unable to answer fully and completely; state the facts on which you rely to support your contention that you are unable to answer such interrogatory fully and

completely; and state what knowledge, information and/or belief you have concerning the unanswered portion of each such interrogatory.

3. If there is any item of information that you refuse to disclose on grounds of privilege or work-product immunity, answer so much of the interrogatory as does not request information for which you claim privilege, state the nature of the privilege you claim, and provide sufficient details, including the nature of the information, its source, its subject matter, and the names of all persons to whom that information was disclosed, such as would enable the claim of privilege or immunity to be adjudicated.

4. If the response to any interrogatory consists, in whole or in part, of an objection relating to burdensomeness, then with respect to such response:

- a. Provide such information as can be ascertained without undue burden;
- b. State with particularity the basis for such objection including:
 - i. a description of the process or method required to obtain any fact responsive to the interrogatory; and
 - ii. the estimated cost and time required to obtain any fact responsive to the interrogatory.

5. These interrogatories are continuing and require further answer and supplementation, as provided by Federal Rule of Civil Procedure 26(e).

INTERROGATORIES

Consistent with the foregoing definitions and instructions, please answer the following Interrogatories:

INTERROGATORY NO. 1:

Identify every product and service you have offered in connection with the mark 3DS.

INTERROGATORY NO. 2:

For each product and service requested to be identified in Interrogatory No.1, identify the persons most knowledgeable about each product or service.

INTERROGATORY NO. 3:

For each product and service requested to be identified in Interrogatory No. 1, identify the time period (including month and year) during which you offered each of those products and services.

INTERROGATORY NO. 4:

For each product and service requested to be identified in Interrogatory No. 1, state the sales, on an annual basis (in terms of dollar volume and units) of such product or service from the date of first use of the mark 3DS in connection with such product or service, through the present.

INTERROGATORY NO. 5:

For each product and service requested to be identified in Interrogatory No. 1, explain the extent to which there has been any interruption to continuous use of the mark 3DS to identify the product or service.

INTERROGATORY NO. 6:

For each product and service requested to be identified in Interrogatory No. 1, identify the persons most knowledgeable about the sales and distribution of the product or service.

INTERROGATORY NO. 7:

For each product and service requested to be identified in Interrogatory No. 1, identify the persons most knowledgeable about the advertising and promotion (including but not limited to

white paper publications, attendance and booth reservation at trade shows, and education initiatives generally) of the product or service.

INTERROGATORY NO. 8:

For each product and service requested to be identified in Interrogatory No. 1, list by calendar year the expenditures you have made on advertising and promotion in the United States for the product or service.

INTERROGATORY NO. 9:

For each product and service requested to be identified in Interrogatory No. 1, identify the nature and title (if applicable) of the media in which all advertisements of the product or service have appeared, including the date of and the geographic scope of such advertisements.

INTERROGATORY NO. 10:

For each product and service requested to be identified in Interrogatory No. 1, identify each of the channels of trade through which the products or services have been or are intended to be offered for sale, distributed, sold or rendered.

INTERROGATORY NO. 11:

For each product and service requested to be identified in Interrogatory No. 1, describe the type of customers to whom you advertise, promote, sell, render, and/or distribute the product or service.

INTERROGATORY NO. 12:

Describe all products, packaging, advertising brochures, websites, social media pages, electronic communications and other materials on which you have displayed the mark 3DS.

INTERROGATORY NO. 13:

Describe all present plans to use the mark 3DS.

INTERROGATORY NO. 14:

Describe all of your efforts or plans to promote or expand awareness of the mark 3DS.

INTERROGATORY NO. 15:

State the reasons why you selected and adopted the mark 3DS, including any marks that were considered in the process of selecting the 3DS mark.

INTERROGATORY NO. 16:

Identify all persons who have participated in any decision to adopt or select the mark 3DS.

INTERROGATORY NO. 17:

Describe any studies, tests, ratings, or surveys related to the quality of the 3DS Products or Services.

INTERROGATORY NO. 18:

Describe any studies, tests, ratings, or surveys related to consumer recognition of the mark 3DS.

INTERROGATORY NO. 19:

Describe in detail each incident, known to you, of actual confusion between you or any of your products and services and between Petitioner or any of its products and services.

INTERROGATORY NO. 20:

For each of the incidents described in response to Interrogatory No. 19, identify the persons with knowledge thereof.

INTERROGATORY NO. 21:

Identify each person who participated in a decision to file any trademark application for registration of the mark 3DS.

INTERROGATORY NO. 22:

Identify every trademark search you conducted relating to the mark 3DS.

INTERROGATORY NO. 23:

Identify (including but not limited to party names, dates of inception and expiration dates) all agreements or contracts regarding the mark 3DS, including any transfer of rights between you and a third party regarding the mark 3DS and any licenses that you maintain with third parties allowing you to use the mark 3DS or allowing a third party to use the mark 3DS, and identify all documents which evidence or memorialize such agreements or contracts.

INTERROGATORY NO. 24:

Describe all efforts you have made to enforce against third parties the rights you claim in the mark 3DS.

INTERROGATORY NO. 25:

Describe any instances in which a third party, other than Petitioner, has challenged the rights you claim in the mark 3DS.

INTERROGATORY NO. 26:

Identify each expert witness that you expect to provide testimony in the above-captioned proceeding, including the facts or subject matter about which they are expected to testify.

INTERROGATORY NO. 27:

Identify the circumstances under which (including, but not limited to, the date) you first became aware of Petitioner or its use of the 3DS mark.

INTERROGATORY NO. 28:

Explain the basis for your denials to Petitioner's claims (including a statement of each fact that evidences or supports such denials) as pleaded in ¶¶ 17-21 and 23 of your Answer.

INTERROGATORY NO. 29:

Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 1 of your Answer.

INTERROGATORY NO. 30:

Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 2 of your Answer.

INTERROGATORY NO. 31:

Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 3 of your Answer.

INTERROGATORY NO. 32:

Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 4 of your Answer.

INTERROGATORY NO. 33:

Explain the basis for the disclaimer in your USPTO Registration No. 4,125,612 for a 3DS AND DESIGN mark that “no claim is made to the exclusive right to use ‘3D’ apart from the mark as shown.”

INTERROGATORY NO. 34:

Explain the basis for the declaration in your USPTO Application Serial No. 85/427,976, filed on November 22, 2011, to register the 3DS AND DESIGN mark that 3D Systems “believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion,

or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”


INTERROGATORY NO. 35:

Identify each person who provided information on which your responses to these Interrogatories are based, specifying the interrogatory or interrogatories for which each person provided information.

Dated: September 6, 2013

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
John L. Slafsky
Hillary I. Schroeder

Attorneys for Petitioner
AUTODESK, INC.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served **PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on September 6, 2013.


Elvira Minjarez

EXHIBIT 4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 4,125,612

Registered: April 10, 2012

Trademark: 3DS & Design

Autodesk, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent.)	
)	

**RESPONDENT'S RESPONSES AND OBJECTIONS TO
PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT**

Respondent, 3D Systems, Inc. ("3D Systems" or "Respondent"), hereby submits its responses and objections to Petitioner Autodesk, Inc.'s ("Autodesk" or "Petitioner") First Set of Interrogatories, as follows:

GENERAL OBJECTIONS

1. Respondent objects to each of Petitioner's Interrogatories to the extent that it is overly broad and unduly burdensome, and purports to impose obligations upon Respondent that exceed the obligations imposed by the Federal Rules of Civil Procedure and the Rules of Practice of the Trademark Trial and Appeal Board.
2. Respondent objects to each of Petitioner's Interrogatories to the extent that it seeks information that is neither relevant to the subject matter of the pending proceeding nor reasonably calculated to lead to the discovery of admissible evidence.

3. Respondent objects to each of Petitioner's Interrogatories to the extent that it is vague and ambiguous and does not employ sufficient detail or reasonable particularity.

4. Respondent objects to each of Petitioner's Interrogatories to the extent that it calls for production of documents or information protected from discovery by the attorney-client privilege, the work product immunity, or any other applicable privilege and/or immunity.

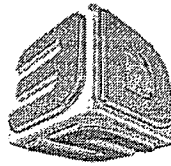
5. Respondent objects to each of Petitioner's Interrogatories to the extent that it calls for production of publicly available information or information that is at least equally available to Petitioner and Respondent.

6. Respondent objects to each of Petitioner's Interrogatories to the extent that it purports to call for the production or disclosure of proprietary and confidential information, non-public information, or trade secrets. Such proprietary and confidential information will be produced only subject to the Protective Order in force in this Cancellation Proceeding.

7. The responses contained herein are based on information presently available to Respondent. Respondent is still engaged in discovery and investigation of this matter, the results of which may alter, modify or add to some of the responses set forth herein. Respondent reserves the right to amend or supplement the following responses based on any further investigation and discovery in this case.

GENERAL OBJECTIONS SPECIFIC TO PETITIONER'S DEFINITIONS AND INSTRUCTIONS

8. Respondent objects to Petitioner's definition of the term "3DS" as including, but not being limited to, the mark 3DS & Design that is the subject of U.S. Reg. No. 4,125,612 and the instant cancellation proceeding. When answering Petitioner's interrogatories, and unless otherwise noted, Respondent will respond only with respect to the mark subject to this proceeding, namely 3DS & Design mark shown below:



Similarly, Petitioner's definition of the terms "3DS," "the mark 3DS," and "the 3DS mark" to include marks other than the mark subject to this proceeding is overly broad, vague and ambiguous, unduly burdensome, and neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

9. Respondent similarly objects to the definition of the term "3DS Product or Services" as overly broad, vague and ambiguous, unduly burdensome, and neither relevant nor reasonably calculated to lead to the discovery of admissible evidence, by referring: (a) to products and services offered and sold in conjunction with "the mark 3DS," and (b) to the extent the interrogatory calls for the provision of information or the production of materials in the possession, custody or control by those other than Respondent, such as its "licensees."

10. Respondent objects to the definition of the term “identify” with respect to a “product” (subsection d) and “service” (subsection e) as overly broad and unduly burdensome, and vague and ambiguous.

11. Respondent objects to the definition of the term “communication” as overly broad and unduly burdensome.

12. Respondent objects to Definition Nos. 13, 14, 15 and 16 as nonsensical and confusing.

13. Respondent objects to Instruction No. 1 to the extent that it calls for the production of information in the possession of Respondent’s attorneys, or persons acting under the direction of Respondent’s attorneys, on the basis that such information is protected from disclosure pursuant to the attorney-client communications privilege or the work product immunity doctrine.

14. Respondent objects to Instruction No. 4 on the grounds that it is overly broad, unduly burdensome, and purports to impose obligations on the Respondent that exceed the obligations imposed by the Federal Rules of Civil Procedure and the Rules of Practice of the Trademark Trial and Appeal Board.

RESPONSES AND OBJECTIONS TO SPECIFIC INTERROGATORIES

Interrogatory No. 1: Identify every product and service you have offered in connection with the mark 3DS.

Response: General Objection No. 1, as to the use of “every,” and No. 8. Subject to and without waiving the foregoing objections, Respondent states that it has sold the following products and services in conjunction with the 3DS & Design mark: solid imaging materials, of plastic, metal, wax, silicone, urethane, ceramic or composites;

computer driven machines for making three-dimensional embodiments of computer printed designs (Cube®, CubeX™, ProJet® 1000, ProJet® 1500, ProJet® 160, ProJet® 260C, ProJet® 3510 SD, ProJet® 3510 HD, ProJet® 3510 HDPlus, ProJet® 3500 HDMax, ProJet® 5000, ProJet® 5500X, ProJet® 6000 SD, ProJet® 7000 SD, ProJet® 6000 HD, ProJet® 7000 HD, iPro™ 8000, iPro™ 8000 MP, iPro™ 9000, iPro™ 9000 XL, sPro™ 140, sPro™ 230, sPro™ 60 HD, sPro™ 60 SD, Phenix PXS, Phenix PXS Dental, ProX™ 200, ProX™ 200 Dental, ProX™ 300); scan based design software (Geomagic Design X, Geomagic Design Direct, Geomagic Capture®, Geomagic Studio, Geomagic Wrap), mechanical design software (Geomagic Design), freeform design software (Geomagic Freeform, Geomagic Freeform Plus, Geomagic Claytools), inspection software (Geomagic Control, Geomagic Verify), healthcare software for conversion of CT scans to 3D models (Bespoke Modeling), haptic devices (Geomagic Touch, Geomagic Touch X, Geomagic Phantom Premium and Geomagic OpenHaptics), 3D scanners (Sense); and manufacturing services, including on-demand production services (Quickparts Solutions), cloud based 3D printing services (Cubify), production software services (SLA® System software, 3DManage™, 3DPrint™, 3DEdit™ Pro, 3D Lightyear™, Buildstation, LS, SinterScan™, RealMonitor™); collaboration software services (TeamPlatform); and optical imaging systems (VIDAR Systems). Respondent further states that some of the above products have been offered and sold in conjunction with the 3DS & Design mark under different specific product names, but the names set forth above are understood to constitute the current product names for the goods and services sold in conjunction with the 3DS & Design mark.

Interrogatory No. 2: For each product and service requested to be identified in Interrogatory No. 1, identify the persons most knowledgeable about each product or service.

Response: General Objection Nos. 1, 8 and 9. Subject to and without waiving the foregoing objection(s), Respondent identifies Cathy Lewis, Chief Marketing Officer, 3D Systems, Inc., as the person most knowledgeable about the scope of 3D Systems' products and services offered and sold in connection with the 3DS & Design Mark.

Interrogatory No. 3: For each product and service requested to be identified in Interrogatory No. 1, identify the time period (including month and year) during which you offered each of those products and services.

Response: General Objection No. 1. Subject to, and without waiving, the foregoing objections, Respondent states that it has used continuously its 3DS & Design Mark in connection with solid imaging materials since at least August 1, 2011, computer driven machines for making three-dimensional embodiments of computer generated designs since at least August 1, 2011, computer software for use in designing three-dimensional objects and controlling machines for making three-dimensional embodiments of the objects since at least August 1, 2011, and manufacturing services pertaining to three-dimensional objects since at least August 1, 2011.

Interrogatory No. 4: For each product and service requested to be identified in Interrogatory No. 1, state the sales, on an annual basis (in terms of dollar volume and units) of such product or service from the date of first use of the mark 3DS in connection with such product or service, through the present.

Response: General Objection Nos. 1, 6, 8 and 9. Subject to and without waiving the foregoing objection(s), Respondent states that its sales, on an annual basis, for all goods and services on or in connection with which the 3DS & Design mark has been used are as follows:

July 1, 2011 – Dec. 31, 2011: \$127,399,000

Jan. 1, 2012 – Dec. 31, 2012: \$353,633,000

Jan. 1, 2013 – Sept. 30, 2013: \$358,583,000

Interrogatory No. 5: For each product and service requested to be identified in Interrogatory No. 1, explain the extent to which there has been any interruption to continuous use of the mark 3DS to identify the product or service.

Response: General Objection No. 3. Otherwise, Respondent incorporates its objections and response to Interrogatory No. 3.

Interrogatory No. 6: For each product and service requested to be identified in Interrogatory No. 1, identify the persons most knowledgeable about the sales and distribution of the product or service.

Response: Respondent incorporates its objections and response to Interrogatory No. 2.

Interrogatory No. 7: For each product and service requested to be identified in Interrogatory No. 1, identify the persons most knowledgeable about the advertising and promotion (including but not limited to white paper publications, attendance and booth reservation at trade shows, and education initiatives generally) of the product or service.

Response: General Objection Nos. 1, 8 and 9. Subject to and without waiving the foregoing objection(s), Respondent identifies Cathy Lewis, Chief Marketing Officer, 3D Systems, Inc., as the person most knowledgeable about the advertising and promotion of 3D Systems' products and services offered and sold in connection with the 3DS & Design Mark.

Interrogatory No. 8: For each product and service requested to be identified in Interrogatory No. 1, list by calendar year the expenditures you have made on advertising and promotion in the United States for the product or service.

Response: General Objection Nos. 1, 6, 8 and 9. Subject to and without waiving the foregoing objections, Respondent states that it has made the following expenditures on advertising and promotion of goods and services on or in connection with which the 3DS & Design Mark has been used:

July 1, 2011 – Dec. 31, 2011: \$ 457,930

Jan. 1, 2012 – Dec. 31, 2012: \$1,747,921

Jan. 1, 2013 – Sept. 30, 2013: \$1,925,812

**Respondent designates this response as CONFIDENTIAL pursuant to the operative protective order."*

Interrogatory No. 9: For each product and service requested to be identified in Interrogatory No. 1, identify the nature and title (if applicable) of the media in which all advertisements of the product or service have appeared, including the date of and the geographic scope of such advertisements.

Response: General Objection Nos. 1 and 2. Subject to and without waiving the foregoing objections, Respondent states that it has advertising the goods and services on or in connection with which the 3DS & Design Mark has been used nationwide, and Respondent will produce a representative sample of advertising from which a sampling of the nature and titles of the media may be ascertained.

Interrogatory No. 10: For each product and service requested to be identified in Interrogatory No. 1, identify each of the channels of trade through which the products or services have been or are intended to be offered for sale, distributed, sold or rendered.

Response: General Objection Nos. 1 and 2. Subject to and without waiving the foregoing objections, Respondent states that its 3DS & Design products and services are

sold and intended to be sold through at least the following channels of trade in this country:

- Over the Internet
- Through various social media and electronic outlets;
- Through direct sales to a variety of industry groups, companies and individuals
- Through sales by distributors and representative groups to companies and individuals
- Through trade show participation and related sales
- Via product catalogs and inside sales

Interrogatory No. 11: For each product and service requested to be identified in Interrogatory No. 1, describe the type of customers to whom you advertise, promote, sell, render, and/or distribute the product or service.

Response: General Objection No. 1. Subject to and without waiving the foregoing objections, Respondent states that the products and services offered and sold under the 3DS & Design Mark are sold to a wide variety of consumers, from hobbyists and product design enthusiasts, to professional engineers and designers in the automotive, aerospace and defense industries, to medical professionals, industrial designers and artists and sculptors, and to general consumers purchasing gifts and novelty items made using additive manufacturing technology.

Interrogatory No. 12: Describe all products, packaging, advertising brochures, websites, social media pages, electronic communications and other materials on which you have displayed the mark 3DS.

Response: General Objection Nos. 1, 3 and 8. Subject to and without waiving the foregoing objections, Respondent identifies the products and services set forth in its response to Interrogatory No. 1 herein, Respondent will produce a sampling of advertising and promotional materials showing the use of the 3DS & Design Mark (see also response to Interrogatory No. 9), and Respondent identifies its website, www.3dsystems.com, and at least the following websites and social media pages as social media and/or electronic media outlets at which it regularly uses and displays the 3DS & Design Mark:

- RSS feed, <http://feeds.feedburner.com/3dSystemsRssNewsFeed>;
- Facebook site: <https://www.facebook.com/3dsystemscorp?ref=ts>
- YouTube page: http://www.youtube.com/channel/UCsx-A5uSO_gYgi5A4RXFCag
- Twitter feed: <https://twitter.com/3dsystemscorp>
- Blog site: <http://www.3dsystems.com/blog>
- LinkedIn page: <http://www.linkedin.com/company/162213>
- Google+ page: <https://plus.google.com/+3dsystems/posts>
- Flickr.com page: <http://www.flickr.com/photos/71069187@N05/>

Interrogatory No. 13: Describe all present plans to use the mark 3DS.

Response: General Objection Nos. 1, 3, 6 and 8. Subject to and without waiving the foregoing objections, and without disclosing Respondent's highly confidential and proprietary marketing plans and strategies, Respondent states that it plans to use the mark 3DS & Design generally in the manners in which it currently uses the mark.

Interrogatory No. 14: Describe all of your efforts or plans to promote or expand awareness of the mark 3DS.

Response: Respondent incorporates its response to Interrogatory No. 13.

Interrogatory No. 15: State the reasons why you selected and adopted the mark 3DS, including any marks that were considered in the process of selecting the 3DS mark.

Response: General Objection No. 8. Respondent adopted the mark 3DS & Design so as to create a brand that is immediately recognizable to consumers, which calls to consumers' and potential consumers' minds the source from which the subject goods and services originate, namely 3D Systems, Inc., by use of the term "3D" and Respondent's 3D & Design mark (see U.S. Reg. No. 3,023,690) and incorporating the letter "S," as an abbreviation for "Systems," and which suggests a quality or characteristic of the products and related services offered and sold by the company through use of the cubical design element.

Interrogatory No. 16: Identify all persons who have participated in any decision to adopt or select the mark 3DS.

Response: General Objection No. 8. The primary persons involved in the decision to adopt or select the mark 3DS & Design were the following:

- Cathy Lewis, Chief Marketing Officer, 3D Systems;
- Avi Reichenthal, President/CEO, 3D Systems;

Interrogatory No. 17: Describe any studies, tests, ratings, or surveys related to the quality of the 3DS Products or Services.

Response: General Objection No. 1, 2 and 9.

Interrogatory No. 18: Describe any studies, tests, ratings, or surveys related to consumer recognition of the mark 3DS.

Response: General Objection No. 8. Respondent is not aware of any “studies, tests, ratings, or surveys” related to consumer recognition of the 3DS & Design Mark.

Interrogatory No. 19: Describe in detail each incident, known to you, of actual confusion between you or any of your products and services and between Petitioner or any of its products and services.

Response: General Objection No. 1, to the extent this request seeks any information pertaining to any mark other than Respondent’s registered 3DS & Design Mark and Petitioner’s 3DS MAX mark. Subject to and without waiving the foregoing objections, Respondent states that it is not aware of any incidents of actual confusion between 3D Systems and its 3DS & Design mark and/or any of its related products and services, on the one hand, and, and Petitioner and its 3DS MAX mark and any of Petitioner’s products and services, on the other hand.

Interrogatory No. 20: For each of the incidents described in response to Interrogatory No. 19, identify the persons with knowledge thereof.

Response: In response to this interrogatory, Respondent incorporates its response to Interrogatory No. 19.

Interrogatory No. 21: Identify each person who participated in a decision to file any trademark application for registration of the mark 3DS.

Response: General Objection No. 8. The primary persons involved in the decision to file U.S. Application No. 85/427,976, which matured into U.S. Reg. No. 4,125,612 for the mark 3DS & Design, were the following:

- Cathy Lewis, Chief Marketing Officer, 3D Systems;

- Avi Reichenthal, President/CEO, 3D Systems;
- Keith Roberson, Intellectual Property & Technology Counsel, 3D Systems;

Interrogatory No. 22: Identify every trademark search you conducted relating to the mark 3DS.

Response: General Objection Nos. 2, 4 and 8.

Interrogatory No. 23: Identify (including but not limited to party names, dates of inception and expiration dates) all agreements or contracts regarding the mark 3DS, including any transfer of rights between you and a third party regarding the mark 3DS and any licenses that you maintain with third parties allowing you to use the mark 3DS or allowing a third party to use the mark 3DS, and identify all documents which evidence or memorialize such agreements or contracts.

Response: General Objection No. 1, 2 and 8, to the extent this request seeks information pertaining to agreements or contracts in which the primary subject matter of the agreement is not the 3DS & Design Mark. Subject to and without waiving the foregoing objections, Respondent states that it is not aware of any agreements or contracts in which the subject matter of the agreement is the 3DS & Design Mark.

Interrogatory No. 24: Describe all efforts you have made to enforce against third parties the rights you claim in the mark 3DS.

Response: General Objection No. 8. Respondent states that, apart from the present proceeding, it has not been involved in any legal proceedings in the United States with respect to its 3DS & Design mark.

Interrogatory No. 25: Describe any instances in which a third party, other than Petitioner, has challenged the rights you claim in the mark 3DS.

Response: General Objection No. 8. Subject to and without waiving the foregoing objections, no other person or entity has challenged Respondent's rights in its 3DS & Design Mark.

Interrogatory No. 26: Identify each expert witness that you expect to provide testimony in the above-captioned proceeding, including the facts or subject matter about which they are expected to testify.

Response: General Objection Nos. 1 and 7. In addition to its foregoing objections, Respondent objects to this Interrogatory on the grounds that it is premature, and calls for the disclosure of information protected by the attorney-client privilege and/or the work product immunity. Subject to, and without waiving, the foregoing objections, Respondent will make disclosures regarding expert witnesses in accordance with the schedule provided by the TTAB for this Cancellation Proceeding.

Interrogatory No. 27: Identify the circumstances under which (including, but not limited to, the date) you first became aware of Petitioner or its use of the 3DS mark.

Response: General Objection Nos. 2 and 3, and because this interrogatory is confusing. Subject to and without waiving the foregoing objection, Respondent states that, as presently understood, Respondent generally has been aware of Petitioner for many years. Respondent first became aware of its own use of its 3DS & Design Mark when it commenced use of the mark on or about May 2011.

Interrogatory No. 28: Explain the basis for your denials to Petitioner's claims (including a statement of each fact that evidences or supports such denials) as pleaded in ¶¶ 17-21 and 23 of your Answer.

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) ("It is settled that a

party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”).

Interrogatory No. 29: Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 1 of your Answer.

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”).

Interrogatory No. 30: Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 2 of your Answer.

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”).

Interrogatory No. 31: Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 3 of your Answer.

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”).

Interrogatory No. 32: Explain the basis for the Affirmative Defense (including a statement of each fact that evidences or supports the Affirmative Defense) as pleaded on page 4, ¶ 4 of your Answer.

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”).

Interrogatory No. 33: Explain the basis for the disclaimer in your USPTO Registration No. 4,125,612 for a 3DS AND DESIGN mark that "no claim is made to the exclusive right to use '3D' apart from the mark as shown."

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”). Subject to and without waiving the foregoing objections, Respondent refers Petitioner to the file history U.S. Reg. No. 4,125,612, which is equally available to Petitioner.

Interrogatory No. 34: Explain the basis for the declaration in your USPTO Application Serial No. 85/427,976, filed on November 22, 2011, to register the 3DS AND DESIGN mark that 3D Systems "believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true."

Response: General Objection Nos. 1, 3 and 4. See also *Time Warner Entertainment Co., L.P. v. Jones*, 65 U.S.P.Q. 1650 (TTAB 2002) (“It is settled that a

party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial”). Subject to and without waiving the foregoing objections, the referenced statement speaks for itself.

Interrogatory No. 35: Identify each person who provided information on which your responses to these Interrogatories are based, specifying the interrogatory or interrogatories for which each person provided information.

Response: General Objection No. 4. Subject to and without waiving the foregoing objections, Respondent identifies the following persons who provided information utilized in preparing these responses:

- Cathy Lewis, 3D Systems, Inc., Response Nos. 1-16, 13-15, 21
- Keith Roberson, Esq., 3D Systems, Inc., generally
- Jason M. Sneed & Sarah C. Hsia, SNEED PLLC, generally

Dated: January 17, 2014



Jason M. Sneed
Sarah C. Hsia
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036
Tel: 704-779-3611
sarah@sneedlegal.com
JSneed@SneedLegal.com

*Attorneys for Respondent
3D Systems, Inc.*

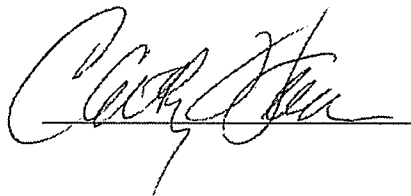
VERIFICATION

I, Cathy Lewis, hereby declare:

I am the CMO of 3D Systems, Inc. I have read the foregoing Responses and Objections to Petitioner's First Set of Interrogatories and know the contents thereof. Based on my personal knowledge or on information provided to me by others, I am informed and I believe that the responses contained therein are true and correct.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 17th day of January, 2014.


A handwritten signature in black ink, appearing to read "Cathy Lewis", is written over a horizontal line.

Certificate of Service

Pursuant to C.R.F. §2.111, I hereby certify that a true and correct copy of the foregoing Respondent's Responses and Objections to Petitioner's First Set of Interrogatories was served on the Petitioner, Autodesk, Inc., by placing a copy in U.S. Mail, postage prepaid, and addressed to the following:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050
Attorneys for Petitioner

This the 17th day of January, 2014.



An Attorney for Respondent

EXHIBIT 5

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: March 22, 2010

Cancellation No. 92048444

Oxford Tutoring Inc.

v.

Oxford Learning Centres,
Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on respondent's motion (filed July 15, 2009). The motion is fully briefed.

Telephone Conference

On March 19, 2010, at approximately 3:00 p.m. EDT, the Board exercised its discretion and conducted a telephone conference to resolve the motion. Participating in the conference were Edward T. Attanasio, counsel for petitioner; Purvi J. Patel, counsel for respondent; and the above-referenced Board attorney responsible for resolving interlocutory matters in this case.¹

The Board considered the comments made by both parties during the telephone conference, as well as the supporting

¹ The Board appreciates the professionalism of the parties during the telephone conference.

motion and briefs. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motion, briefs, or during the telephone conference. Instead, this order outlines the decisions made by the Board.

Procedural Issues

As a procedural matter, the Board noted petitioner's December 22, 2009 appearance of new counsel.

The Board also noted that inasmuch as Trademark Rule 2.127(a) provides that "[t]he time for filing a reply brief will not be extended," respondent's reply brief should have been filed by August 24, 2009. Notwithstanding Trademark Rule 2.127(a), the Board had previously granted respondent's consented motions (filed September 4 and 22, 2009) to extend respondent's time in which to file a reply brief based on the parties' settlement negotiations. Inasmuch as the Board had granted the motions to extend, and as a matter of equity, respondent's reply (filed September 29, 2009) was considered.

Motion to Quash

On June 6, 2009, petitioner served notice of an oral deposition of respondent under Fed. R. Civ. P. 30(b)(6). By way of its motion, respondent seeks to quash the notice of deposition and seeks to proceed with any discovery

deposition of respondent by the manner prescribed by Trademark Rule 2.124 (depositions on written questions).

During the telephone conference, and in an effort to resolve the outstanding matter, petitioner offered to travel to respondent's corporate office in Canada, to the offices of respondent's counsel in the United States, or to any location to conduct the discovery deposition by oral examination. Citing cost as a deterrent, respondent declined petitioner's offer but remained amenable to a deposition on written questions.

Trademark Rule 2.120(c)(1) states:

The discovery deposition of a natural person residing in a foreign country who is ... a person designated under Rule 30(b)(6) ... shall, if taken in a foreign country be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in Trademark Rule 2.124. Moreover, the Board will not order a natural person, including a person designated under Fed. R. Civ. P. 30(b)(6), residing in a foreign country to come to the United States for the taking of his or her discovery

deposition. TBMP §520 (2d ed. rev. 2004). See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978). See also TBMP §§ 404.03(b) and 521.

Inasmuch as respondent is a Canadian corporation with no corporate presence in the United States, and no officer, director, managing agent, or other person who consents to testify on its behalf residing in the United States, respondent's motion was granted. Accordingly, petitioner's notice of an oral deposition of respondent was quashed.

Schedule

Proceedings were resumed, and discovery was reopened for the sole purpose of allowing petitioner to depose respondent. Dates were reset on the schedule below.

Expert Disclosures Due	5/23/2010
Discovery (for Deposition of Respondent) Closes ²	6/22/2010
Plaintiff's Pretrial Disclosures	8/6/2010
Plaintiff's 30-day Trial Period Ends	9/20/2010
Defendant's Pretrial Disclosures	10/5/2010
Defendant's 30-day Trial Period Ends	11/19/2010
Plaintiff's Rebuttal Disclosures	12/4/2010
Plaintiff's 15-day Rebuttal Period Ends	1/3/2011

² It is noted that respondent expressed its willingness to cooperate in a deposition on written questions, and to cooperate in requests to extend or suspend proceedings if petitioner is unable to complete the deposition by June 22, 2010.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Possible Settlement

The parties stated that although no settlement proposal was under active consideration, each party remained open to the possibility of settlement. The Board informed the parties that the Board is liberal with regard to suspension of proceedings to accommodate settlement discussions.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served:

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL DEPOSITIONS ON ORAL EXAMINATION

DECLARATION OF CHRIS YOUNG

DECLARATION OF FMAURICE PATEL

DECLARATION OF LUKE LISS IN SUPPORT OF PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL DEPOSITIONS ON ORAL EXAMINATION

on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on January 2, 2015.


Elvira Minjarez